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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,498	08/05/2003	Randall Woods	27593CIP	7062
33357 7590 05/27/2009 ABBOTT MEDICAL OPTICS, INC. 1700 E. ST. ANDREW PLACE SANTA ANA, CA 92705				
EXAMINER MATTHEWS, WILLIAM H				
ART UNIT 3774		PAPER NUMBER		
MAIL DATE 05/27/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/634,498

Applicant(s)

WOODS ET AL.

Examiner

William H. Matthews (Howie)

Art Unit

3774

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 32-69 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39,47, and 60-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 39 and 60-69 describe in combination, "resilient shape-retaining synthetic material" and "gels or liquids". The specification fails to describe gels or liquids which are resilient and shape-retaining. Claim 47 contains new matter because it broadly encompasses arrangements which were not disclosed such as "posterior segments joined by an annular portion located anterior of the optic".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33,40,44,51,52,54,56,57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 40 recites "optics", there is insufficient antecedent basis for a plurality of optics.

Claims 44 and 57 recite the outer body forming an enclosure and also including an opening. Therefore it is unclear how the outer body encloses the optic.

Claims 51 and 56 define the segments "disposed about a plane". It is unclear how this is possible as they are disposed about the optical axis. Furthermore, "disposed about" implies "positioned around" and not including that which it is disposed about (such as an axis or the opening of claim 52). Claims 33 and 54 recite similar limitations regarding disposed about a plane.

Claims 52 and 57 recite the opening including the central axis. This is unclear, and Examiner suggests replacing "including" with --crossing--.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanna USPN 6749634, or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Hanna USPN 6749634 in view of Horn et al. USPN 4888012 ("Horn").

Hanna discloses an accommodating lens system for placement in the capsular bag. See figures 15-22. The lens includes an optic 101 constructed of resilient shape retaining material (c6:1-7) and positioning member 130/104/110 including an outer arcuate body having a plurality of spaced apart anterior and posterior segments/legs 132/133 (fig 22) connected at bights along an equator, and radially extending arms 104 between the optic and outer body along a straight line (fig 18). Anterior and posterior openings are also provided by the anterior and posterior segments wherein the optic is located therebetween.

The limitations regarding changing of shape of the optic to produce different thicknesses is considered intended use (see MPEP 2113). Hanna provides optic material which is capable of deformation to produce different thicknesses, and thus the structure of Hanna anticipates claims 32-41,44-48,50-59.

Alternatively, and with further regard to claims 60-69, Hanna is silent as to an optic for deforming in response to ciliary body movement wherein the optic is formed

with liquid or gel. Horn teach vaulting accommodating intraocular lenses can be improved by utilizing a liquid or gel filled optic that changes in thickness to produce greater accommodation range (c1:27-c2:50). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the vaulting optic lens assembly of Hanna to include a liquid or gel filled lens that changes shape, as taught by Horn, in order to provide greater range of accommodation for patients in need of greater accommodation ranges.

Regarding claims 42,43 and 49, Hanna and Horn are silent as to the dimension along the optical axis and the diopter power of the lens. However, Hanna and Horn are directed to capsular bag implants which are adapted to treat a wide range of patients. Therefore it would have been obvious to one of ordinary skill in the art to select the particular sizes and optical powers in order to fit a particular patients needs. Furthermore, the claimed ranges are well within ranges known in the art and would thus be a matter of obvious design choice.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Matthews (Howie) whose telephone number is 571-272-4753. The examiner can normally be reached on Monday-Friday 10-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William H. Matthews/
Primary Examiner
Art Unit 3774